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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-----------------------|---------------------|------------------|
| 09/897,572      | 07/02/2001  | Daniel Stedman Connor | 7949                | 1222             |

27752 7590 02/03/2004

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| EXAMINER |
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TOOMER, CEPHIA D

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1714

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/897,572             | CONNOR ET AL.       |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Cephia D. Toomer       | 1714                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 07 November 2003.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-73 is/are pending in the application.  
 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-17,26,29,32,35-45,48,51,55,56,59-66,69 and 73 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) The translation of the foreign language provisional application has been received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.  
 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**Continuation of Disposition of Claims:** Claims withdrawn from consideration are 18-25,27,28,30,31,33,34,46,47,49,50,53,54,57,58,67,68 and 70-72.

**DETAILED ACTION**

***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Election/Restrictions***

2. Applicant's election with traverse of Group I in Paper No. 110703 is acknowledged. The traversal is on the ground(s) that the cited references do not provide evidence that the claimed inventions listed in Groups I-III are not related as a single general inventive concept and do not correspond to the same special technical feature. This is not found persuasive because as stated in the prior office action the hydrocarbon fuel does not provide a contribution over the prior art and the alcohols are not the same. Even though claim 1 does not specifically teach how the alcohol is made, the lack of such a limitation strengthens the examiners position that the alcohols may not be the same.

The requirement is still deemed proper and is therefore made FINAL.

3. It is noted that applicant has amended the elected claims 15-17, 55, 56 and 73. Applicant has not identified these claims as amended.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-17, 26, 29, 32, 35-45, 48, 51 55-56, 59-66, 69 and 73 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-3, 6-17 and 73, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(c).

In the penultimate line of claim 6, "fule" is misspelled.

In claim 11, the recitation "said combustion engine is diesel engine" is indefinite because it places a further limitation on Applicant's intended use for the fuel, but it does not place any further limitation on the fuel composition per se.

In claim 13, the recitation "said combustion engine is a new compact diesel engine or other nontraditional engine" is indefinite because it places a further limitation on Applicant's intended use for the fuel, but it does not place any further limitation on the fuel composition per se.

In claim 14 ( c ), fourth bullet, it is not clear what this language means.

Clarification is required.

In claim 15, "R wherein" is not understood.

Claim 26 is rejected because it is not clear how the fuel is biodegraded simply by disposing of it. Clarification is required.

Claims 55 and 56 are not understood. There is no antecedent support within the claim itself or the claims from which the present claims are dependents for  $C_bH_{2b-2}$ , K, L and Q.

Claim 66 is rejected because it is not clear what "low ambient temperature conditions" mean. Is the temperature lower than room temperature but higher than freezing? Clarification is required.

Claim 73 is rejected because there is no antecedent support within the claim itself for X, Y, Z, E and G. Also, there is no antecedent support for the language "said nonlinear primary aliphatic Oxo alcohol (b)" and "said nonlinear diols (b)" nor is there support for their respective ratio.

6. Claim 29 provides for the use of a fuel composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 29 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 48, 49 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Franz (US 4,859,210).

Franz teaches a fuel composition for IC engines comprising a polyisobutyl alcohol ( $\text{RCH}_2\text{OH}$ ) (see abstract). Franz contains no teaching of using native F.T. alcohols or diols. The polyisobutyl alcohol is a monohydric alcohol. The fuel composition contains from 0.005 to 0.5% of the alcohol (see col. 6, lines 46-50 and claim 1).

Accordingly, Franz teaching all the limitation of the claims anticipates the claims.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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9. Claims 1, 29, 32, 41, 44, 48, 59, 60, 61, 64 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Yeh (US 6,447,557).

Yeh teaches a fuel composition wherein the base fuel (diesel fuel or jet or mixture thereof) has no more than 50 ppm sulfur, no more than 10% by weight olefin, and no more 10% by weight esters. These values read on zero. Yeh is silent with respect to aldehydes; therefore, it is implied that the composition contains 0% aldehydes. The fuel composition contains at least 1% by weight of a C<sub>4</sub>-C<sub>20</sub> alcohol (see abstract; col. 2, lines 65-67; col. 3, lines 1-17). The alcohols may be a mixture of linear and nonlinear alcohols; however, the preferred alcohols have branched chains of and are non-Fischer Tropsch (see col. 3, lines 54-68; col. 4, lines 1-10).

The fuel composition may contain conventional diesel fuel additives (see col. 5, lines 21-31). The IC engine has a compression ratio of 13.37:1 (see Table 1).

Accordingly, Yeh teaching all the limitations of the claims, anticipates the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Sophia D. Toomer  
Primary Examiner  
Art Unit 1714

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